

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Status

In this response claim 35 has been written to assume independent form. Claims 2-5, 7-20, 22, 24-35 remain pending in this application. Of these, claims 2-4, 15, 22, 24, 31 and 33 are allowed.

Rejections Under 35 USC § 102

The rejection of claims 5, 7-14,k 16-20 and 32 under 35 USC § 102(b) as being anticipated by Knowles et al. is respectfully traversed.

In this rejection it is again asserted that Knowles et al. discloses each and every feature set forth in the rejected claims. This position is traversed.

In this rejection the position is taken that, given a certain interpretation of the disclosure of Knowles et al, the steps recited in the rejected claims are disclosed as being carried out in the listed sequence. However, there is no showing the rejection that the steps which are disclosed at various different locations throughout the document are in fact each carried out one-after-the-other (viz.,sequentially). Indeed, the only discussion of this sequential requirement is on page 2 of this Office Action wherein it stated that:

“Upon review of this reference Knowles the examiner **believes that the reference can still be interpreted as teaching this limitation. Particularly, in column 16, lines 38 through 40, Knowles reads that ‘the bar cod menu can be printed out locally and then transmitted to a remote location by way of facsimile transmission for print out and subsequent use’.**” (Emphasis added)

Unfortunately, it is necessary for more than “belief” to be expressed before a *prima facie* case of anticipation can be established. For a tenable rejection, it must be pointed out where in the reference this sequential disclosure is set forth. The manner in which the rejection flits about the Knowles et al. disclosure, viz., columns: 16 → 8 → 17 → 14 (and 17) → 22 → 9 (and 15), renders it virtually impossible to show that the identified steps were carried out in the sequence required in the rejected claims. Indeed, the Applicants take the position that the rejection fails to properly establish that the claimed sequence of steps are in fact disclosed as being carried out in the required sequence in the reference to Knowles et al.

More specifically, the rejection states that “the remote location is interpreted as the final addressee destination of a fax, whereby the remote location, for its ‘subsequent use’, performs the scanning, decoding, selecting of a communication address, and initiating a communication. “ The Applicants take issue with the reliance on “for its ‘subsequent use’.” It seems that the rejection is based on this tenuous presumption that faxing to a remote location establishes that all of the steps quoted from the various different locations in Knowles are carried out in a sequential manner. However, the term “subsequent” does not import the meaning of “sequential” nor does it suggest anything is carried out in a given sequence. Inasmuch as this is the hinge for the holding of anticipation, it must be submitted that the rejection is insufficiently supported and therefore untenable.

This logic used above is as defective as that used in connection with claim 10. The position that, if a part of an object is “not visible to the naked eye” then the remainder of the object is also not visible to the naked eye, simply defies comprehension.

Claim 10 requires that the “communication mark is not visible to the unaided human eye.” It does not call for “at least a part of the communication mark to be visible to the unaided human eye” or the “communication mark is, in part, not visible to the unaided human eye.” Claim 10 calls for the communication mark to be not visible. This claim does not call for just a part of the communication mark to be not visible. The PTO cannot interpret claims as if they had been rewritten for the purpose of rejection.

The position that “not visible” is not the same as “invisible” is an interesting one. However, this does not allow one to place a baseball cap over a side mirror of an automotive vehicle (so that the mirror per se cannot be seen and therefore ‘not visible’) and have the whole vehicle removed from view. It is simply not going to happen. Therefore, just how part of the bar code being rendered “not visible” to the naked eye renders the remainder which is clearly not disclosed as being ‘not visible’, not visible, is not understood.

Rejections Under 35 USC § 103

The rejection of claim 35 under 35 USC § 103(a) as being unpatentable over Knowles et al. in view of Wang et al. is respectfully traversed.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered.

In this rejection, the position is taken that it would be obvious to render the bar codes of Knowles et al. invisible as per the teachings of Wang et al. The motivation for this transfer of teachings is that it would not allow humans to view the information and prevent any stealing or tampering with the code.

However, the very essence of Knowles et al. is that the user must be able to see (viz., view) the bar codes that are associated with the information that is required so that they may be easily picked off using a hand-held scanner – see Figs 1-3 of Knowles et al. for example. Making the bar codes invisible would render it difficult, if not impossible in some cases, to find the bar codes and successfully scan the same. This would amount to a change which would render the Knowles et al. arrangement at least partially inoperative for its intended purpose. That is to say, you can’t scan what you can’t see and therefore cannot find.

"If the proposed modification would render the prior art invention being modified unsatisfactory for its intended

purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." M.P.E.P. § 2143.01.

Reconsideration of this rejection and the allowance of claim 35 as rewritten to assume independent form, is courteously solicited.

Conclusion

It is respectfully submitted that this Office Action has, for at least the reasons advanced above, failed to establish either *prima facie* case of anticipation or a *prima facie* case of obviousness. Favorable reconsideration and allowance of all claims pending in this application is courteously solicited.

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